



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,693	10/10/2001	Benoit Patrick Bertrand	05222.00149	3225

29638 7590 02/04/2005

BANNER & WITCOFF AND ATTORNEYS FOR ACCENTURE
10 S. WACKER DRIVE, 30TH FLOOR
CHICAGO, IL 60606

EXAMINER

HIRL, JOSEPH P

ART UNIT PAPER NUMBER

2121

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/868,693

Applicant(s)

BERTRAND ET AL.

Examiner

Joseph P. Hirl

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 16, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 020205.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to an AMENDMENT entered November 16, 2004 for the patent application 09/868,693 filed on October 10, 2001.
2. The First Office Action of August 16, 2004 is fully incorporated into this Final Office Action by reference.

Status of Claims

3. Claim 1 was amended. Claims 1-18 are pending.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 2121

5. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

6. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1 and 10 are rejected under the judicially created doctrine of double patenting over claims 1 and 10 of U. S. Patent No. 6,782,374 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

8. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: although the conflicting claims are not identical, they are not patentable distinct from each other because receiving, integrating and evaluating goal information is not distinct from accessing, utilizing, monitoring and retrieving goal information of a type to be found in a spreadsheet data structure.

9. Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Cook et al (WO 97/44766 referred to as **Cook**).

Claims 1, 10

Cook anticipates (a) receiving information indicative of a goal organized in a spreadsheet data structure (**Cook**, p 7, l 37; p 11, l 32-33; Examiner's Note (EN): schedules are spreadsheet applications); (b) integrating information that motivates accomplishment of the goal into the spreadsheet data structure for use in the presentation (**Cook**, p 8, l 9-13; p11, l 32-33); (c) evaluating progress toward the goal and providing feedback that further motivates accomplishment of the goal based on information contained in the spreadsheet data structure (**Cook**, p 10, l 28-31; p 8, l 8-13; p 11, l 32-33) (EN: receiving information in a computerized implementation implies a processor, memory and controlling logic).

Claims 2, 11

Cook anticipates the step of interpreting the spreadsheet data structure and presenting information utilizing a visual basic engine (**Cook**, p 11, l 32-33; p

Art Unit: 2121

76, l14-31; p 76, l 14-31; EN: visual basic, developed by Microsoft, is a programming language in general use).

Claims 3, 12

Cook anticipates the step of monitoring the goal and analyzing intermediate results using analytical tools to alter the presentation (**Cook**, p 89, l 31-37, p 90, all, p 91, all; EN: the analytic tools are embedded in the computer software).

Claims 4, 13

Cook anticipates including the step of simulating a business activity (**Cook**, p 12, l 3-24; EN: monitoring progress is a business activity).

Claims 5, 14

Cook anticipates the step of receiving an indicia from a user and altering the business simulation as a function of the indicia (**Cook**, p 12, l 21-24;).

Claim 6

Cook anticipates the step organizing feedback categorically (**Cook**, p 12, l 3-24; EN: organized by student).

Claims 7, 16

Cook anticipates the step of adjusting the feedback based on information stored in the spreadsheet (**Cook**, p 11, l 32-36);

Claim 8, 17

Cook anticipates the step of passing information from the presentation to an expert system to analyze the information and formulate the appropriate

Art Unit: 2121

feedback (**Cook**, p 59, I 12-30; the agent is the expert system operating on rules and inference implementation).

Claims 9, 18

Cook anticipates the step of utilizing at least one application programming interface to exchange information from the presentation with another application (**Cook**, p 76, I 14-31).

Claim 15

Cook anticipates including logic that organizes the presentation into states and utilizes the states to alter the presentation (**Cook**, p 91, I 3-16)

Response to Arguments

12. The proposed amended title is acceptable.
13. No typographical error of the "(c)" type was amended. Please clarify in response to this office action.
14. Based on the response to the "Request for Information", the applicant has inferred that Smialek does not have a position against the instant application and that the Response of February 7, 2002 is complete. Therefore, the Examiner withdraws the "Request for Information."
15. The objection to the Information Disclosure Statement is withdrawn.
16. The drawing objection is withdrawn.
17. The specification objection is withdrawn.
18. The abstract objection is withdrawn.

Art Unit: 2121

19. The terminal disclaimer related to US Patent 6,016,486 satisfies the nonstatutory double patenting rejection related to claims 1 and 10. Nonstatutory double patenting rejection related to application 09/219,478 (US Patent 6,782,374) remains.

20. The rejection of claims 1 and 10 under 35 USC 102(f) and (g) is withdrawn.

21. The rejection of claim 1 under 35 USC 112, second paragraph, is withdrawn conditioned on the applicant's binary definition of the term "motivates."

22. The rejection of claims 1-9 under USC 101 is withdrawn.

23. Applicant's arguments filed on November 16, 2004 related to Claims 1-18 have been fully considered but are not persuasive.

In reference to Applicant's argument:

Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/44766 (Cook). Claim includes the feature of "evaluating progress toward the goal and providing feedback that further motivates accomplishment of the goal based on information contained in the spreadsheet data structure." The Office Action alleges in an Examiner's Note that "schedules are spreadsheet applications." (Page 1, line 3.) (The Office Action admits that an Examiner Note is "a link to prior art that one of ordinary skill in the art would find inherently appropriate.") If this were the case, then "evaluating progress toward the goal and providing feedback that further motivates accomplishment of the goal" would be based on information contained in a schedule. However, a schedule merely indicates assigned student activities and cannot be indicative of a student's progress.

Examiner's response:

The point by point anticipation by Cook to all claims was put forth in the First Office Action dated August 16, 2004. Para 26 below applies appropriately.

"Evaluating progress toward the goal and providing feedback that further motivates accomplishment of the goal based on information contained in the

Art Unit: 2121

spreadsheet data structure" was anticipated by Cook @ p 10, l 28-31; p 8, l 8-13; p 11, l 32-33). The EN related to "schedules are spreadsheet applications" was made in regard to "receiving information indicative of a goal organized in a spreadsheet data structure." First Office Action applies.

In reference to Applicant's argument:

Similarly, claim 10 includes the feature of "logic that evaluates progress toward a goal and providing feedback that further motivates accomplishment of the goal based on information contained in the spreadsheet data structure."

Examiner's response:

The above discussion applies. Evaluation is logic based. First Office Action applies.

Examination Considerations

24. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, l 45-48; p 2100-9, c 1, l 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art.

Such an approach is broad in concept and can be either explicit or implicit in meaning.

25. Examiner's Notes are provided to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and unless otherwise stated, the Examiner's Notes are not prior art but a link to prior art that one of ordinary skill in the art would find inherently appropriate.

26. Examiner's Opinion: Paras 24. and 25. apply. The Examiner has full latitude to interpret each claim in the broadest reasonable sense.

Conclusion

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory

Art Unit: 2121

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

28. Claims 1-8 are rejected.

Correspondence Information

29. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is (571) 272-3685. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anthony Knight can be reached at (571) 272-3687.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,

Washington, D. C. 20231;

or faxed to:

(703) 872-9306 (for formal communications intended for entry);

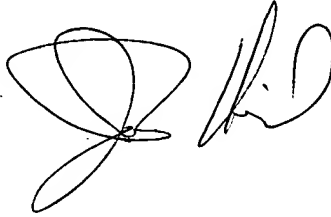
or faxed to:

Art Unit: 2121

(571) 273-3685 (for informal or draft communications with notation of
"Proposed" or "Draft" for the desk of the Examiner).

Joseph P. Hirl

February 2, 2005

A handwritten signature in black ink, consisting of a large, stylized 'J' followed by a smaller, more fluid signature.